

REMARKS

Claims 1, 3-15, and 17-19 are pending in the application. Claims 2, 16, 20-25, and 34 have been cancelled. Claims 26-33 and 35 have been previously withdrawn. Claim 1 has been amended to more particularly point out and claim the invention. In particular, claim 1 has been amended to incorporate subject matter recited in original claims 2 and 16 to clarify that the invention comprises a polymer additive selected from a group including poly(acrylonitrile-co-butadiene-co-acrylic acrylic acid, dicarboxy terminated glycidyl methacrylate diester (ABA-glycidyl methacrylate diester) oligomer) and oligomeric additive amine terminated poly(acrylonitrile-co-butadiene), as well as mixtures containing these compounds. Support for the amendment of claim 1 is found at least in original claims 2 and 16. Similarly, claim 19 has been amended to incorporate subject matter recited in original claim 25. Claims 3, 4, 9, and 13 have been amended to address rejections under 35 U.S.C. §112. Additionally, claims 6-8, 10-12, 17, and 19 have also been amended, for consistency with amended claims 3, 4, and 9. Claims 14, 15, and 18 have been amended to depend from claim 1, rather than cancelled claim 2. No new matter has been added by the foregoing amendments.

Claim Rejections – 35 U.S.C. §112 – claims 3, 4, 9, 13, and 20-25

The Examiner has objected to claims 3, 4, 9, 13, and 20-25 as being indefinite. In particular, the Examiner states that it is unclear how carbon fibers and carbon micro-fibers recited in claims 3 and 9 are “metal filler particles”. The Examiner further states that it is unclear how inorganic filler recited in claim 13 is “metal filler particles”. In view of the Examiner’s comments, Applicants have amended claims 1, 3, 4, and 9 to recite “filler particles” rather than “metal filler particles”, thus clarifying that the carbon fiber, carbon micro-fibers, and inorganic filler are “filler particles” rather than “metal filler particles”. The Examiner states that there is insufficient antecedent basis for the feature of “thermally conductive and electrically insulative inorganic filler” recited in claim 13. Applicants have amended claim 13 to depend from claim 4, rather than claim 1. Claim 4 provides proper antecedent basis for the inorganic filler recited in claim 13. In view of cancellation of claims 20-24, rejection of these claims is moot. Claim 25 has also been cancelled, but subject matter of claim 25 has been incorporated into claim 19. The Examiner states that claim 25 recites the trademark/trade name “DMP-30”,

rendering the claim indefinite. The Examiner further states that claim 25 recites the acronym "MA", the meaning of which is unclear. In view of the Examiner's comments, Applicants have modified the subject matter from claim 25 now incorporated into claim 19, to delete both "DMP-30" and "MA". Applicants note that "DMP-30" is a trade name for a tertiary amine epoxy accelerator having the chemical name "2,4,6-tris (dimethylaminomethyl) phenol". Please note the attached catalog tear sheet from SPI Supplies showing the equivalence of these terms. Thus, the person of ordinary skill in the art will recognize that recitation of "DMP-30" in original claim 25 was redundant with recitation of "the tertiary amine 2,4,-tris(dimethylamino-methyl)phenol". Applicants respectfully submit that with these amendments, the issues relating to 35 U.S.C. §112 raised by the Examiner have been addressed. Applicants respectfully request that the rejections of claims 3, 4, 9, 13 under 35 U.S.C. §112 be withdrawn.

Claim Rejections – 35 U.S.C. § 102 – claims 1-3, 6, 7, and 14-18

The Examiner has rejected claims 1-3, 6, 7, and 14-18 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,700,581 (Sachdev *et al.*, hereinafter "Sachdev '581"). In view of the amendment of claim 1, Applicants respectfully traverse rejections of claims 1, 3, 6, 7, 14, 15, 17, and 18 under 35 U.S.C. § 102(b). In view of cancellation of claims 2 and 16, rejection of these claims is now moot.

Claim 1 has been amended to incorporate subject matter from claims 2 and 16. In particular, claim 1, as amended, is directed to a reworkable conductive adhesive composition, and recites, *inter alia*:

...
said polymer additive is selected from the group consisting of poly(n-butylacrylate; n-butylmethacrylate); poly(n-fluorobutyl methacrylate); poly(methyl methacrylate), **poly(acrylonitrile-co-butadiene-co-acrylic acid, dicarboxy terminated glycidyl methacrylate diester (ABA-glycidyl methacrylate diester) oligomer); oligomeric additive amine terminated poly(acrylonitrile-co-butadiene), and mixtures thereof.**
(Emphasis added.)

The relevant subject matter "poly(acrylonitrile-co-butadiene-co-acrylic acid, dicarboxy terminated glycidyl methacrylate diester (ABA-glycidyl methacrylate diester) oligomer);

oligomeric additive amine terminated poly(acrylonitrile-co-butadiene), and mixtures thereof” has been incorporated into claim 1 from cancelled claim 16. In the rejection of claim 16, the Examiner has relied upon Sachdev ‘581, in particular the Abstract, the claims, and the specification at column 5, line 64 through column 6, line 4.

Sachdev ‘581 discloses an epoxy-based adhesive suitable for use in semiconductor manufacturing. With respect to polymer additives, Sachdev ‘581 discloses:

[t]he acrylate polymer optional co-additives to provide reworkable adhesive formulations include polyacrylates and polymethacrylates and polyalkyl acrylates and polyalkyl methacrylates such as poly(n-butylacrylate and/or n-butylmethacrylate), poly(n-fluorobutyl methacrylate), and polymethyl methacrylate. In general, the alkyl group may be about C1-C8, preferably C2-C4. The acrylate polymer is preferably miscible in the adhesive formulation.

Sachdev ‘581 at column 5, line 64 to column 6, line 4. Further, in claim 5, Sachdev ‘581 similarly discloses:

...
an additive to the composition wherein the additive enables the bonded components to be reworked without the need for solvents which additive is selected from the group consisting of polyacrylate, poly(meth)acrylate, polyalkylacrylate and polyalkylmethacrylate, polyfluoro alkyl acrylate and polyfluoroalkyl methacrylate wherein the alkyl group is C1-C8.

Clearly, in the cited passages, as well as in the remainder of the claims and specification, Sachdev ‘581 fails to disclose the elements recited in claim 1, as amended, of “poly(acrylonitrile-co-butadiene-co-acrylic acid, dicarboxy terminated glycidyl methacrylate diester (ABA-glycidyl methacrylate diester) oligomer); oligomeric additive amine terminated poly(acrylonitrile-co-butadiene), and mixtures thereof”.

Sachdev ‘581 fails to disclose each and every feature of claim 1, as amended (as well as claims 3, 6, 7, 14, 15, 17, and 18 depending from claim 1). Accordingly, it is respectfully requested that the rejection of claims 1, 3, 6, 7, 14, 15, 17, and 18 under 35 U.S.C. § 102(b) be withdrawn.

Claim Rejections – 35 U.S.C. § 102/103 – claims 1-3, 6, 7, and 14-18

The Examiner has rejected claims 1-3, 6, 7, and 14-18 under 35 U.S.C. §102(b) as being anticipated by, or in the alternative, under 35 U.S.C. §103(a) as obvious over, U.S. Patent No. 6,548,175 (Sachdev *et al.*, hereinafter “Sachdev ‘175”). In view of the amendment of claim 1, Applicants respectfully traverse these rejections of claims 1, 3, 6, 7, 14, 15, 17, and 18 under 35 U.S.C. §102(b) / 35 U.S.C. §103(a). In view of cancellation of claims 2 and 16, rejection of these claims is now moot.

As noted above, the subject matter “poly(acrylonitrile-co-butadiene-co-acrylic acid, dicarboxy terminated glycidyl methacrylate diester (ABA-glycidyl methacrylate diester) oligomer); oligomeric additive amine terminated poly(acrylonitrile-co-butadiene), and mixtures thereof” has been incorporated into claim 1 from cancelled claim 16. In the rejection of claim 16, the Examiner has relied upon the Abstract, the claims, and the specification at column 6, lines 49-67 of Sachdev ‘175.

Sachdev ‘175 discloses epoxy-siloxane based adhesives suitable for use in semiconductor manufacturing. With respect to polymer additives, Sachdev ‘175 discloses:

[t]he acrylate polymer optional co-additives to provide reworkable adhesive formulations include polyacrylates and polymethacrylates and polyalkyl acrylates and polyalkyl methacrylates such as poly(n-butylacrylate and/or n-butylmethacrylate), poly(n-fluorobutyl methacrylate), and polymethyl methacrylate. In general, the alkyl group may be about C1-C8, preferably C2-C4. The acrylate polymer is preferably miscible in the adhesive formulation.

Sachdev ‘175 at column 6, lines 49-67. Further, in claim 5, Sachdev ‘581 similarly discloses:

...
an additive to the composition wherein the additive enables the bonded components to be reworked without the need for solvents which additive is selected from the group consisting of polyacrylate, poly(meth)acrylate, polyalkylacrylate and polyalkylmethacrylate, polyfluoro alkyl acrylate and polyfluoroalkyl methacrylate wherein the alkyl group is C1-C8.

Clearly, in the cited passages, as well as in the remainder of the claims and specification, Sachdev '175 fails to disclose the elements recited in claim 1, as amended, of "poly(acrylonitrile-co-butadiene-co-acrylic acid, dicarboxy terminated glycidyl methacrylate diester (ABA-glycidyl methacrylate diester) oligomer); oligomeric additive amine terminated poly(acrylonitrile-co-butadiene), and mixtures thereof".

Relative to the rejection under 35 U.S.C. §102(b), Sachdev '175 fails to disclose each and every feature of claim 1, as amended (as well as claims 3, 6, 7, 14, 15, 17, and 18 depending from claim 1). Accordingly, it is respectfully requested that the rejection of claims 1, 3, 6, 7, 14, 15, 17, and 18 under 35 U.S.C. § 102(b) be withdrawn.

Relative to the alternative rejection under 35 U.S.C. §103(a), when making a rejection under 35 U.S.C. §103, the Examiner has the burden of establishing a *prima facie* case of obviousness. The Examiner satisfies this burden only by showing: (1) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, (2) a reasonable expectation of success, and (3) the prior art references much teach or suggest all of the claim limitations (see MPEP 706.02(j)). The teaching or suggestion to make the claim combination and reasonable expectation of success must be found in the prior art and not from the applicant's disclosure (see MPEP 706.02(j)).

There is no teaching or suggestion found in Sachdev '175 to expand the disclosed list of polymer additives to include "poly(acrylonitrile-co-butadiene-co-acrylic acid, dicarboxy terminated glycidyl methacrylate diester (ABA-glycidyl methacrylate diester) oligomer); oligomeric additive amine terminated poly(acrylonitrile-co-butadiene), and mixtures thereof" as is recited in claim 1, as amended. It is therefore respectfully submitted that a *prima facie* case for obviousness has not been established with respect to claim 1, as amended (as well as claims 3, 6, 7, 14, 15, 17, and 18 depending from claim 1). Accordingly, it is respectfully requested that the alternative rejection of claims 1, 3, 6, 7, 14, 15, 17, and 18 under 35 U.S.C. § 103(a) be withdrawn.

Claim Rejections – 35 U.S.C. § 103 – claims 4, 5, 8, 12, 13, and 19-25

The Examiner has rejected claims 4, 5, 8, 12, 13, and 19-25 under 35 U.S.C. §103(a) as unpatentable over Sachdev ‘581. In view of the amendment of claims 1 and 19, Applicants respectfully traverse these rejections of claims 4, 5, 8, 12, 13, and 19 under 35 U.S.C. §103(a). In view of cancellation of claims 20-25, rejection of these claims is now moot.

Claim 19 has been amended to incorporate subject matter from cancelled claim 25. In particular, claim 19, as amended, is directed to a method for making a conductive adhesive composition, and recites, *inter alia*:

...
said liquid epoxy precursor is a soluble mixture of 1,3-bis(glycidoxypentyl) tetramethyl disiloxane and **said polymer additive is poly (ABA-glycidyl methacrylate oligomer)** and said first mixture is prepared by heating with stirring at approximately 50° C.;... . (Emphasis added.)

The relevant subject matter “poly (ABA-glycidyl methacrylate oligomer)” has been incorporated into claim 19 from cancelled claim 25. The subject matter “poly (ABA-glycidyl methacrylate oligomer)” recited in claim 19, as amended, is not disclosed by Sachdev ‘581. Moreover, there is no teaching or suggestion found in Sachdev ‘581 to expand the list of polymer additives it does disclose to include “poly (ABA-glycidyl methacrylate oligomer)” as is recited in claim 19, as amended. It is therefore respectfully submitted that a *prima facie* case for obviousness has not been established with respect to claim 19, as amended.

Similarly, relative to the rejection of claims 4, 5, 8, 12, and 13, the relevant subject matter “poly(acrylonitrile-co-butadiene-co-acrylic acid, dicarboxy terminated glycidyl methacrylate diester (ABA-glycidyl methacrylate diester) oligomer); oligomeric additive amine terminated poly(acrylonitrile-co-butadiene), and mixtures thereof” recited in claim 1, as amended, is not disclosed by Sachdev ‘581. Moreover, there is no teaching or suggestion found in Sachdev ‘581 to expand the list of polymer additives it does disclose to include “poly(acrylonitrile-co-butadiene-co-acrylic acid, dicarboxy terminated glycidyl methacrylate diester (ABA-glycidyl methacrylate diester) oligomer); oligomeric additive amine terminated poly(acrylonitrile-co-butadiene), and mixtures thereof” as is recited in claim 1, as amended. It is therefore respectfully

submitted that a *prima facie* case for obviousness has not been established with respect to claim 1, as amended, as well as claims 4, 5, 8, 12 depending from claim 1.

Accordingly, it is respectfully requested that the rejection of claims 4, 5, 8, 12, 13, and 19 under 35 U.S.C. § 103(a) be withdrawn.

Claim Rejections – 35 U.S.C. § 103 – claims 8 and 19-25

The Examiner has rejected claims 8 and 19-25 under 35 U.S.C. §103(a) as obvious over Sachdev '175. In view of the amendment of claims 1 and 19, Applicants respectfully traverse these rejections of claims 8 and 19 under 35 U.S.C. §103(a). In view of cancellation of claims 20-25, rejection of these claims is now moot.

Relative to the rejection of claim 8, the relevant subject matter “poly(acrylonitrile-co-butadiene-co-acrylic acid, dicarboxy terminated glycidyl methacrylate diester (ABA-glycidyl methacrylate diester) oligomer); oligomeric additive amine terminated poly(acrylonitrile-co-butadiene), and mixtures thereof” recited in claim 1, as amended, is not disclosed by Sachdev '175. Moreover, there is no teaching or suggestion found in Sachdev '175 to expand the list of polymer additives it does disclose to include “poly(acrylonitrile-co-butadiene-co-acrylic acid, dicarboxy terminated glycidyl methacrylate diester (ABA-glycidyl methacrylate diester) oligomer); oligomeric additive amine terminated poly(acrylonitrile-co-butadiene), and mixtures thereof” as is recited in claim 1, as amended. It is therefore respectfully submitted that a *prima facie* case for obviousness has not been established with respect to claim 1, as amended, as well as claim 8 depending from claim 1.

Relative to the rejection of claim 19, the relevant subject matter “poly (ABA-glycidyl methacrylate oligomer)” recited in claim 19, as amended, is not disclosed by Sachdev '175. Moreover, there is no teaching or suggestion found in Sachdev '175 to expand the list of polymer additives it does disclose to include “poly (ABA-glycidyl methacrylate oligomer)” as is recited in claim 19, as amended. It is therefore respectfully submitted that a *prima facie* case for obviousness has not been established with respect to claim 19, as amended.

Accordingly, it is respectfully requested that the alternative rejection of claims 8 and 19 under 35 U.S.C. § 103(a) be withdrawn.

Claim Rejections – 35 U.S.C. § 103 – claims 9-11

The Examiner has rejected claims 9-11 under 35 U.S.C. §103(a) as obvious over Sachdev ‘581 or Sachdev ‘175 in view of U.S. Patent No. 6,977,025 (McArdle *et al.*, hereinafter “McArdle”). In view of the amendment of claim 1, Applicants respectfully traverse these rejections of claims 9-11 under 35 U.S.C. §103(a).

McArdle is directed to a method of forming a monolayer of substantive particles having a particle size on at least one dimension thereof of at least 1 micrometer and being in two or more groups of different sizes. McArdle also provides a method of forming a monolayer of substantive particles in a non-random array where the curable composition comprises a ferrofluid composition.

Assuming *arguendo* that McArdle is properly combinable with either Sachdev ‘581 or Sachdev ‘175 under 35 U.S.C. §103, the relevant subject matter recited in claim 1 of “poly(acrylonitrile-co-butadiene-co-acrylic acid, dicarboxy terminated glycidyl methacrylate diester (ABA-glycidyl methacrylate diester) oligomer); oligomeric additive amine terminated poly(acrylonitrile-co-butadiene), and mixtures thereof” is not disclosed by Sachdev ‘581, Sachdev ‘175, or McArdle, either individually or in the proposed combination. Moreover, there is no teaching or suggestion found in Sachdev ‘581, Sachdev ‘175, or McArdle to expand the list of polymer additives disclosed by the references to include “poly(acrylonitrile-co-butadiene-co-acrylic acid, dicarboxy terminated glycidyl methacrylate diester (ABA-glycidyl methacrylate diester) oligomer); oligomeric additive amine terminated poly(acrylonitrile-co-butadiene), and mixtures thereof” as is recited in claim 1, as amended. It is therefore respectfully submitted that a *prima facie* case for obviousness has not been established with respect to claim 1, as amended, as well as claims 9-11 depending from claim 1. Accordingly, it is respectfully requested that the alternative rejection of claims 9-11 under 35 U.S.C. § 103(a) be withdrawn.

Claim Rejections – 35 U.S.C. § 103 – claim 34

The Examiner has rejected claim 34 under 35 U.S.C. §103(a) as obvious over Sachdev ‘581 or Sachdev ‘175 in view of U.S. Patent Application Publication No. 2002/0171132 (Buchwalter *et al.*). In view of cancellation of claim 34, rejection of claim 34 is now moot.

Claim Rejections – Double Patenting – claims 1, 2, 14-16, and 19

The Examiner has rejected claims 1, 2, 14-16, and 19 on the ground of nonstatutory obviousness-type double patenting as unpatentable over claims 1-22 of Sachdev ‘581. Applicants respectfully traverse rejection of claims 1, 14, 15, and 19. In view of cancellation of claims 2 and 16, rejection of these claims is now moot.

As discussed above, Sachdev ‘581 fails to teach, disclose, or suggest at least the features of “poly(acrylonitrile-co-butadiene-co-acrylic acid, dicarboxy terminated glycidyl methacrylate diester (ABA-glycidyl methacrylate diester) oligomer); oligomeric additive amine terminated poly(acrylonitrile-co-butadiene), and mixtures thereof” recited in claim 1, as amended, or “poly (ABA-glycidyl methacrylate oligomer)” recited in claim 19, as amended. Applicants respectfully submit that claim 1 (as well as claims 14 and 15 depending from claim 1) and claim 19 are patentably distinct over claims 1-22 of Sachdev ‘581. Accordingly, Applicants respectfully request that rejection of claims 1, 14, 15, and 19 on the ground of nonstatutory obviousness-type double patenting be withdrawn.

Claim Rejections – Double Patenting – claims 3-8, 12, 13, 17, 18, and 20-25

The Examiner has rejected claims 3-8, 12, 13, 17, 18, and 20-25 on the ground of nonstatutory obviousness-type double patenting as unpatentable over claims 1-22 of Sachdev ‘581, in light of the specification. Applicants respectfully traverse rejection of claims 3-8, 12, 13, 17, and 18. In view of cancellation of claims 20-25, rejection of these claims is now moot.

As discussed above, Sachdev ‘581 fails to teach, disclose, or suggest at least the features of “poly(acrylonitrile-co-butadiene-co-acrylic acid, dicarboxy terminated glycidyl methacrylate diester (ABA-glycidyl methacrylate diester) oligomer); oligomeric additive amine terminated

poly(acrylonitrile-co-butadiene), and mixtures thereof” recited in claim 1, as amended. Applicants respectfully submit that claim 1, as well as claims 3-8, 12, 13, 17, and 18 depending from claim 1, are patentably distinct over claims 1-22 of Sachdev ‘581, in light of the specification. Accordingly, Applicants respectfully request that rejection of claims 3-8, 12, 13, 17, and 18 on the ground of nonstatutory obviousness-type double patenting be withdrawn.

Claim Rejections – Double Patenting – claims 1, 2, 14-16, and 19

The Examiner has rejected claims 1, 2, 14-16, and 19 on the ground of nonstatutory obviousness-type double patenting as unpatentable over claims 1-15 of Sachdev ‘175. Applicants respectfully traverse rejection of claims 1, 14, 15, and 19. In view of cancellation of claims 2 and 16, rejection of these claims is now moot.

As discussed above, Sachdev ‘175 fails to teach, disclose, or suggest at least the features of “poly(acrylonitrile-co-butadiene-co-acrylic acid, dicarboxy terminated glycidyl methacrylate diester (ABA-glycidyl methacrylate diester) oligomer); oligomeric additive amine terminated poly(acrylonitrile-co-butadiene), and mixtures thereof” recited in claim 1, as amended, or “poly (ABA-glycidyl methacrylate oligomer)” recited in claim 19, as amended. Applicants respectfully submit that claim 1 (as well as claims 14 and 15 depending from claim 1) and claim 19 are patentably distinct over claims 1-15 of Sachdev ‘175. Accordingly, Applicants respectfully request that rejection of claims 1, 14, 15, and 19 on the ground of nonstatutory obviousness-type double patenting be withdrawn.

Claim Rejections – Double Patenting – claims 3, 6-8, 17, 18, and 20-25

The Examiner has rejected claims 3, 6-8, 17, 18, and 20-25 on the ground of nonstatutory obviousness-type double patenting as unpatentable over claims 1-15 of Sachdev ‘175, in light of the specification. Applicants respectfully traverse rejection of claims 3, 6-8, 17, and 18. In view of cancellation of claims 20-25, rejection of these claims is now moot.

As discussed above, Sachdev ‘175 fails to teach, disclose, or suggest at least the features of “poly(acrylonitrile-co-butadiene-co-acrylic acid, dicarboxy terminated glycidyl methacrylate diester (ABA-glycidyl methacrylate diester) oligomer); oligomeric additive amine terminated

poly(acrylonitrile-co-butadiene), and mixtures thereof” recited in claim 1, as amended.

Applicants respectfully submit that claim 1, as well as claims 3, 6-8, 17, and 18 depending from claim 1, are patentably distinct over claims 1-15 of Sachdev ‘175, in light of the specification. Accordingly, Applicants respectfully request that rejection of claims 3, 6-8, 17, and 18 on the ground of nonstatutory obviousness-type double patenting be withdrawn.

Claim Rejections – Double Patenting – claims 9-11

The Examiner has rejected claims 9-11 on the ground of nonstatutory obviousness-type double patenting as unpatentable over claims 1-22 of Sachdev ‘581, or over claims 1-15 of Sachdev ‘175, in light of the specifications, and in view of McArdle. Applicants respectfully traverse rejection of claims 9-11.

As discussed above, Sachdev ‘581, Sachdev ‘175, and McArdle fail, both individually and in combination, to teach, disclose, or suggest at least the features of “poly(acrylonitrile-co-butadiene-co-acrylic acid, dicarboxy terminated glycidyl methacrylate diester (ABA-glycidyl methacrylate diester) oligomer); oligomeric additive amine terminated poly(acrylonitrile-co-butadiene), and mixtures thereof” recited in claim 1, as amended. Applicants respectfully submit that claim 1, as well as claims 9-11 depending from claim 1, are patentably distinct over claims 1-22 of Sachdev ‘581, claims 1-15 of Sachdev ‘175, in light of the specifications, and in view of McArdle. Accordingly, Applicants respectfully request that rejection of claims 9-11 on the ground of nonstatutory obviousness-type double patenting be withdrawn.

Claim Rejections – Double Patenting – claim 34

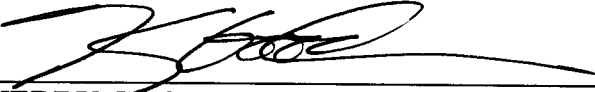
The Examiner has rejected claim 34 on the ground of nonstatutory obviousness-type double patenting as unpatentable over claims 1-22 of Sachdev ‘581, or over claims 1-15 of Sachdev ‘175, in view of Buchwalter *et al.* In view of cancellation of claim 34, this rejection is now moot.

CONCLUSION

In view of the foregoing amendment and remarks, Applicants respectfully submit that the present application, including claims 1, 3-15, and 17-19, is in condition for allowance, and such action is respectfully requested.

Respectfully submitted,

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